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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 718.

GENERAL MOTORS CORPORATION, *Petitioner,*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

BRIEF OF AMICI CURIAE.

This brief is filed by William B. Kerkam and John J. Darby, as amici curiae on behalf of the American Patent Law Association, in support of the petition for writ of certiorari to the United States Court of Appeals for the District of Columbia filed in this cause on October 27, 1941.

This brief is directed to the following points:

1. That there is actually presented as a basis for decision in this cause, the question whether the United States Court of Appeals for the District of Columbia, in an action against the Commissioner of Patents under U. S. C. Title 35, Sec.

63, should resolve against the applicant for patent doubt as to the existence of invention;

2. That the United States Court of Appeals for the District of Columbia in an action under U. S. C. Title 35, Sec. 63 to obtain Letters Patent should not resolve doubts as to the presence or absence of invention against an applicant for patent, and that where such doubts are found to exist, the finding destroys any presumption as to the correctness of the District Court's decision;

3. That the decision of the United States Court of Appeals for the District of Columbia on this question is in conflict with decisions of other courts, and is in conflict with prior decisions of the Court of Appeals;

4. That an early authoritative resolution of the existing conflict of decision on this question is of general public importance.

I. The Question of the Effect of Doubt as to the Existence of Invention is Directly Involved in the Decision of the Court of Appeals.

In the opinion of the Court of Appeals of the District of Columbia in this cause (120 F. (2d) 736, Record 455-457) it clearly appears that the Court of Appeals recognized that the record before the Court indicated doubt as to the existence of invention in the subject-matter of the claims involved in the appeal.

The Court stated unequivocally:

> "We agree that the presence or absence of invention is doubtful in this case." (Record 456)

The Court then stated:

> "But 'whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously

not law in relation to appeals from the District Court' ",

citing *Minnesota Mining & Mfg. Co.* v. *Coe,* 118 F. (2d) 593, 594.

Since the "older decisions," which we discuss hereinafter at pages 4-5, would appear to have required a decision in favor of the inventor where doubt as to invention is found to exist, the ruling of the Court of Appeals on this question was apparently the determining factor in the decision.

II. The Finding by the Court of Appeals that Presence or Absence of Invention is Doubtful Automatically Eliminated the Presumption that the District Court was Correct Which Would Exist in the Absence of Such Finding.

The statement in the Court of Appeals decision (p. 2, *ante*) that the long established rule that doubts in appeals from the Patent Office are to be resolved in favor of an applicant is "obviously not the law in relation to appeals from the District Court", presumably refers to the rule that findings of a District Court shall not be set aside unless clearly erroneous*. Apparently, the Court regarded this latter rule as inconsistent with statements in its previous decisions that doubts should be resolved in favor of an applicant.

But there is no inconsistency between the two rules where, as in the case at bar, the Court of Appeals finds that doubt as to the presence or absence of invention does exist. The finding of the existence of a doubt automatically destroys the presumption as to the District Court's correctness, since it is equivalent to a holding that the District Court should have found a doubt, and it is the established

*Rule 52, Rules of Civil Procedure.

rule that where such a doubt exists, the District Court should issue the patent. See the decisions cited at pages 4-5.

Consequently, the presumption as to the District Court's correctness, which the Court of Appeals apparently had in mind in saying that its older decisions resolving doubts in favor of an applicant are not the law in relation to appeals from the District Court, has no application to this case. It is submitted that in any case where the Court of Appeals finds a doubt as to the presence or absence of invention, it should resolve that doubt in favor of the applicant in accordance with long-established precedent.

III. The Ruling of the Court of Appeals is in Conflict with Other Decisions of the Court of Appeals and with Decisions of Other Courts.

Heretofore it has been a uniform rule of decision, in the courts of the United States and in the tribunals of the patent system, that doubt as to the existence of invention should be resolved in favor of the inventor. We confine our consideration to cases involving a review of refusal of the Commissioner of Patents to issue a patent, since in such cases the resolution of doubt in favor of the inventor is not weighted by any presumption of validity of an issued patent.

1. *Prior Decisions of the Court of Appeals of the District of Columbia.*

Typical of the "older decisions" referred to by the Court of Appeals in its opinion in the present case is *Battery Patents Corporation* v. *Coe,* 93 F. (2d) 220 in which the Court said, at page 226:

> "We are aware that this court has said that in case of serious doubt in the mind of the court after a careful review of the evidence, the doubt should be resolved in favor of the one seeking a patent."

The Court of Appeals of the District of Columbia, when it exercised the jurisdiction under U. S. C. Title 35, Sec. 59a now held by the Court of Customs and Patent Appeals, followed the same rule. In the case of *In re Davidson*, 12 F. (2d) 814, the Court said:

> "Moreover, where the question of patentability is close, the doubt should be resolved in favor of the applicant". (Citing cases)

2. *Decisions of Other United States Courts.*

In appeals from the Patent Office to the Court of Customs and Patent Appeals under the provisions of U. S. C. Title 35, Sec. 59a, that Court has consistently followed the rule of resolving doubt of invention in favor of the inventor. In its opinion in *In re Coley*, 40 F. (2d) 982, the Court said:

> "Where there is such doubt, the scales should be inclined toward the applicant". (Citing cases)

In *In re Kirschbraun*, 44 F. (2d) 675, the same Court said:

> "The familiar rule that any doubt should be resolved in favor of the applicant is here applicable".

The United States District Court for the District of Maryland has confirmed the same rule of resolving doubt in favor of the inventor in cases heard by that Court under the provisions of U. S. C. Title 35, Sec. 63. *Berry* v. *Robertson*, 40 F. (2d) 915; *Kaplan* v. *Robertson*, 50 F. (2d) 617.

IV. The Public Interest Requires an Early Resolution of this Conflict.

It is highly undesirable that the rule of decision which will be followed in a case should depend upon the court in which the case may be heard. The evils resulting from

such a situation were pointed out by the Supreme Court in *Erie R. Co.* v. *Tompkins,* 304 U. S. 64.

It is furthermore desirable that a radical change in a long-established rule of decision should be reviewed by the Supreme Court, particularly when, as in the present case, the new rule of decision threatens substantially to nullify the right to a review of decisions of the Patent Office tribunals granted to inventors by U. S. C. Title 35, Sec. 63. The new rule of decision amounts, in effect, to an amendment of the Congressional enactment and inventors and the general public alike are entitled to have this alteration in the incidence of the statute carefully scrutinized by this Court.

Conclusion.

For the reasons outlined above, it is earnestly submitted that the present cause involves a reversal of a well-established rule of decision in conflict with a long line of prior decisions of the Court of Appeals of the District of Columbia and of other courts of the United States, clearly calling for review and determination of the conflict by this Court.

It is therefore requested that the petition for writ of certiorari filed herein be granted.

Respectfully submitted,

WILLIAM B. KERKAM,
JOHN J. DARBY,
Amici Curiae.

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CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondent.

REPLY BRIEF FOR PETITIONER.

GENERAL MOTORS CORPORATION,

By DRURY W. COOPER,
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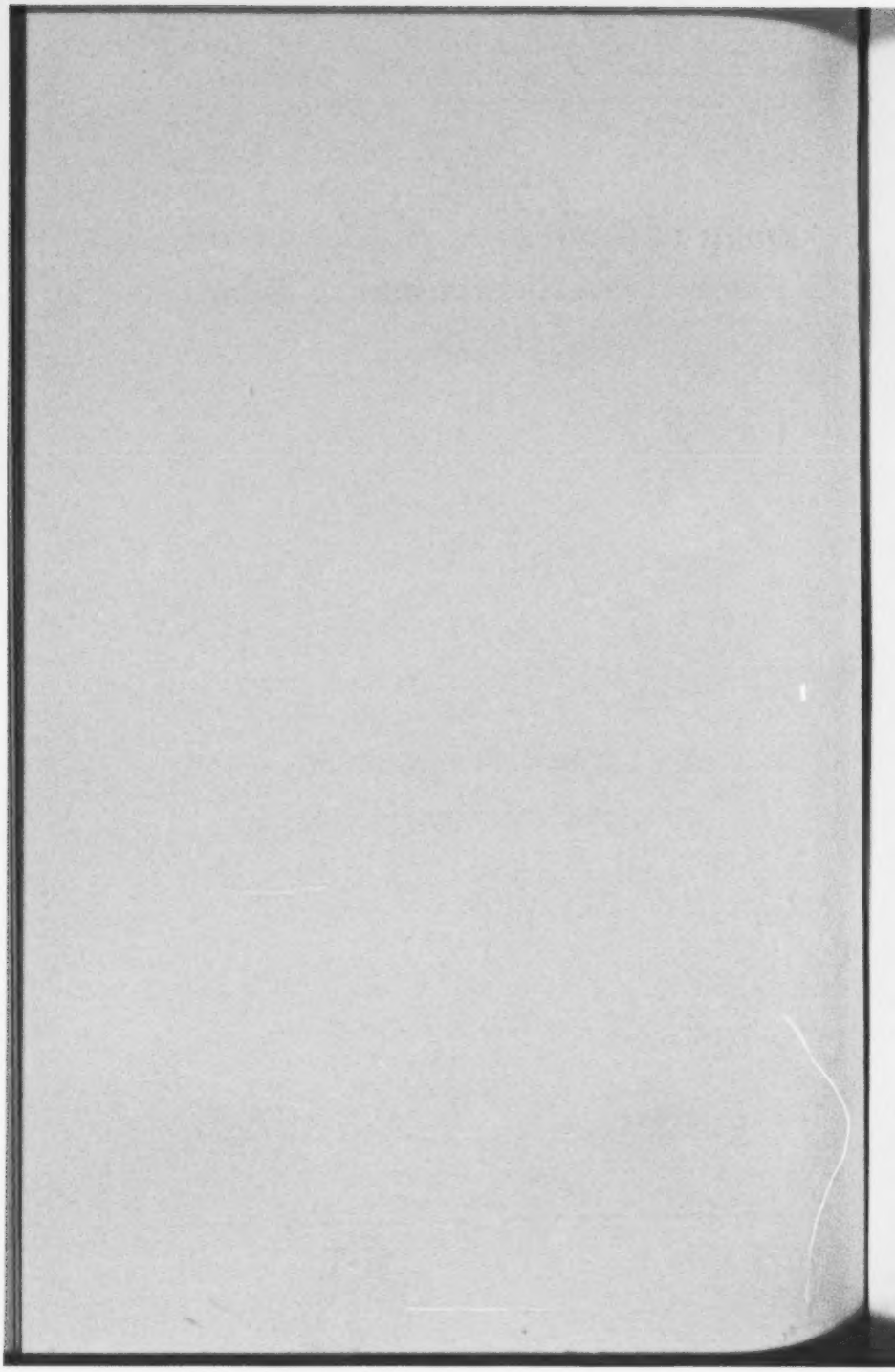

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REPLY BRIEF FOR PETITIONER.

The petition points out certain questions that are presented by the decision of the Court of Appeals in this case (Pet. 7-8). The respondent's brief does not controvert the proposition that these questions should be passed on by this Court.

The respondent's brief evades these questions. Most of it (the section numbered 1 on pp. 5-7) is devoted to a discussion of the scope of appellate review which the petitioner did not question. The very brief remainder of the respondent's brief (the section numbered 2 on pp. 7 and 8) purports to be a discussion of something which approximates a question the petition points out is presented by the

decision of the Court of Appeals but twists itself into a discussion of whether commercial success, of itself, conclusively entitles the applicant to the grant of a patent. The latter question was not presented to or passed on by the Court of Appeals and nothing with respect to it is found in the petition.

The *restatement* on page 2 of the respondent's brief of the questions presented are not only confusing but incorrect. The questions are clearly, concisely and accurately stated on pages 7 and 8 of the petition and we do not understand why the respondent should have considered it necessary to *restate* them as he did except as a basis for discussing something else.

The purpose of the petition in this case was not so much, as one might gather from the respondent's brief, to present our position with respect to a rule of law, as to urge that the Court settle which of two antagonistic rules, both by the Court of Appeals for the District of Columbia, is the proper rule of law to determine patentability in cases in which there is substantial, well-founded doubt of lack of invention.

SECTION 1 OF RESPONDENT'S BRIEF.

In this case the Court of Appeals did review the evidence and did find *as a fact,* and did not merely assume, that "the presence or absence of invention is doubtful in this case" (R. 456). Assuming that in effect, as the respondent contends (Resp. Br. 4, footnote 2), the District Court found no invention, this was a ruling that the finding of the District Court was "clearly erroneous or without support in the evidence."

Although there is in our mind no doubt that there is invention of high order in this case, we do not in the petition discuss that but proceed on the basis that the finding "the presence or absence of invention is doubtful in this

case"* presents the question whether the Court of Appeals applied the correct rule of law to such finding of fact.

As we showed on pages 24-26 of the petition, the questions presented by the petition are not answered by stating the rule of presumption of correctness of the decisions of lower tribunals. This rule and the rule as to resolution of doubt of lack of invention are separate and distinct; they are consistent rules and should not be confused as they have been by the Court of Appeals and the respondent.

The respondent says (Resp. Br. 6) resolution of doubt of invention in favor of the applicant is not required by statute, but we submit it is. R. S. Sec. 4915 (Resp. Br. 2) requires that the court determine "according to law" whether the applicant is entitled to a patent, and elementary law as we showed on pages 25 and 26 of the petition demands the rule.

The cases from the Court of Appeals of the District of Columbia on appeal from the Patent Office, from the Court of Customs and Patent Appeals, and from the District Court for the District of Maryland cited in the petition, contrary to respondent's assertion, do support the proposition to which we cited them, viz., that substantial, well-founded doubt of lack of invention is to be resolved in favor of the applicant. Quotations from decisions of these courts are found on pages 18 and 19 of the petition. No reason exists for a different rule in the Court of Appeals for the District of Columbia than in other courts.

The decisions of the Court of Appeals for the District of Columbia in actions under R. S. Sec. 4915, viz., *Thornton* v. *Coe, Carbide and Carbon Chemicals Corp.* v. *Coe, Battery Patents Corporation* v. *Coe* and *Freyn Engineering Co.* v. *Coe,* also support this rule. We quoted from *Freyn*

* Re the statement on page 4 of the respondent's brief that "The Petitioner does not contend that the District Court's finding of no invention is without substantial support in the evidence." The District Court made no "finding of no invention." In the petition, page 4, we pointed out that "The District Court made no finding of fact (R. 90-92) to support its conclusions that the claims it disallowed were not patentable." We do emphatically contend that a finding of no invention would have been not only "without substantial support in the evidence" but "clearly erroneous."

Engineering Co. v. *Coe* on page 20 of the petition. We quote below from *Thornton* v. *Coe* (102 F. 2d 252):

> "We think that Thornton's accomplishment of adjustability is such that *it cannot be said that want of invention is clear,* and we may therefore properly resort to utility and commercial success to remove any remaining doubt (citing Minerals Separation vs. Hyde; DeForest Radio Co. vs. Gen. Electric; Smith vs. Goodyear Dental Vulcanite). It appears that the problem of spreading the heads of the warper beams confronted the textile industry for at least *eight years* after the issuance of the patent to Peterson, before Thornton solved it with the adjustable disk; and it appears that Thornton's improvement was *a distinct success. This is highly persuasive of invention.*" (Italics supplied.)

Nothing could more clearly indicate the division in the Court of Appeals for the District of Columbia itself. *Thornton* v. *Coe* is the direct antithesis of the decision in this case.

It is immaterial whether or not the Court of Appeals in *Thornton* v. *Coe,* etc., held the decisions of the lower tribunals clearly erroneous. The important thing is that the Court of Appeals recognized that the rule of doubt as to invention applied by it in appeals from the Patent Office and applied by the District Court for the District of Maryland, the Court of Customs and Patent Appeals and the Patent Office was applicable to appeals in actions under R. S. Sec. 4915. When compared with these cases the decision in the present case is a departure from the previously universally applied rule and shows that the Court of Appeals itself is divided on the proper rule to apply in cases in which substantial, well founded doubt of lack of invention is found.

SECTION 2 OF RESPONDENT'S BRIEF.

The second of the "Questions Presented" (Res. 2) does not do justice to what the record shows. There was not mere commercial success, but (our footnote at p. 6 of the

petition) there was proof of all the factors accepted by courts as indicia of an especially meritorious invention, the first of its kind. Truly, there was commercial success of an extraordinary kind because of the exceptional practical merit of and need for the invention.

We make no contention that commercial success, of itself, will compel the grant of a patent, but we submit it is settled law that where there is doubt of lack of invention extraneous indicia of invention, of which commercial success is only an example, are resorted to to resolve the doubt in favor of patentability. The respondent does not controvert this; instead he sets up a straw man to knock down.

CONCLUSION.

The respondent's conclusion that "The decision below is in accord with settled principle and no conflict exists" is manifestly incorrect. The decision is contrary to previously settled and universally applied law and conflict manifestly exists. The question on which the decision of the Court of Appeals turned is of great importance and we, therefore, submit the petition should be granted and the decision reviewed.

General Motors Corporation,

By Drury W. Cooper,
Frank E. Liverance, Jr.,
Counsel for Petitioner.